

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. Claims 1-2, 4, 7, 9, 11-12, 14, and 21-30 have been amended to clarify aspects of the inventions.

Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0120925 ("Logan") in view of U.S. 2002/0120925 ("Novak"). Claims 11-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Novak, and further in view of U.S. 2003/0122966 ("Markman"). The Applicants respectfully traverse these rejections for at least the following reasons:

### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of

ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Logan and Novak Does Not Render Claims 1-10 Unpatentable**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Logan and Novak does not disclose or suggest at least the limitation of “establishing a personal television channel at a first geographic location,” as recited by the Applicant in independent claim 1. Applicant's claim 1 is clear that a personal television channel is established, not merely a library of media content that a user and/or others can download.

The Final Office Action cites Logan at [0107], lines 1-3 as disclosing “establishing a personal television channel.” See the Final Office Action at page 3. This portion of Logan recites, however, the following:

Community Markup (CM) may be created as a byproduct of the user's use of locally generated metadata for creating a **personalized program library**. For example, the user may record a lengthy radio broadcast from a favorite station and then selects particular songs for inclusion in a **personal library**, either by using markup signals provided by an remote markup source, or by using the available editing tools at 135, the songs which are identified may contain DJ talkover at the beginning or end of the song. In that case, the user may employ a one-step-editing feature that permits the user to listen to a song and, when a transition occurs from talk

to music, or visa versa, they can simply click on a "scissors" button which moves the start-point or end point of play, for that song, so that, the next time it's played, the new start and/or end point takes effect. Importantly, the talkover is not erased and the play marker is merely moved. If the user did not time very well the use of the scissors, he can hit an "undo" button and redo the clipping process.

See Logan at [0107] (emphasis added). Thus, Logan is clear that a "personalized program library" is created. This portion of Logan does not describe, teach or suggest, however, that the user broadcasts or otherwise communicates television shows or that the user establishes a personalized television channel. Instead, it merely discloses that the user may record and edit radio broadcasts and select particular songs for inclusion in a personal library.

Indeed, Logan is clear that the "Community Markup" is used to "allow users to join a community whereby they will be able to upload their improved markups to a central server at 113 so that other users may access them." See *id.* at [0102]. In short, Logan discloses a system and method in which a user may record specific programs and save them in a **personal library**, at which point the programs may be uploaded by those in a community so that the recorded programs may be marked up. See *id.* at [0100] – [0107] and [0288]. The Applicants respectfully submit, however, that the portion of Logan relied on by the Final Office Action does not describe, teach or suggest "establishing a personal television channel at a first geographic location," as recited in Applicant's claim 1. Novak does not overcome this deficiency of Logan.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Logan and Novak does not disclose or suggest at least the limitation of "associating said produced media program

and said edited metadata with said established personal television channel,” as recited by the Applicant in independent claim 1. The Final Office Action concedes, in page 3, that “Logan does not teach associating the produced media program with the established personal television channel.” The Final Office Action then relies for support on FIG. 8 and ¶ 0062 of Novak. The Applicant points out that even though Novak discloses the creation of a synthetic channel, Novak does not disclose, teach or suggest that produced media program (i.e., modified media content) and corresponding edited metadata is associated with an established personal television channel, as recited in Applicant’s claim 1.

Claims 9-10 depend on claim 1 and are, therefore, also submitted to be allowable based on the above argument. At least the above reasons, the Applicant respectfully requests reconsideration of the rejection of claims 1-10 as being unpatentable over Logan in view of Novak.

## **II. The Rejection of Claims 11-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being anticipated by Logan in view of Novak has been overcome and request that the rejection be withdrawn. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

Additionally, since the additional cited reference (Markman) does not overcome the deficiencies of Logan and Novak, claims 2-10, 12-20, and 22-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 11-31.

### **III. Conclusion**

In general, the Office Action makes various statements regarding claims 1-31 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. The Applicant expressly reserves the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future rejection).

The Applicant respectfully requests reconsideration of the objections and rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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